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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,006	08/04/2003	David Thompson	F-7443 U-D	5041
7590 12/12/2003 LERNER AND GREENBERG, P.A. POST OFFICE BOX 2480 HOLLYWOOD, FL 33022-2480			EXAMINER PARSLEY, DAVID J	
			ART UNIT 3643	PAPER NUMBER

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,006

Applicant(s)

THOMPSON, DAVID

Examiner

David J Parsley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Detailed Action

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is a dependent claim dependent on itself and it is unclear to which claim this claim depends from and it is unclear to how the components of claim 11 relate to the other components of the claimed invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,460,306 to Rudd or U.S. Patent No. 4,827,654 to Roberts.

Referring to claim 1, Rudd and Roberts disclose a fishing rod holder comprising a first pipe section – at 11 of Rudd and – at 16 of Roberts, having an insertion opening, a connection

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area opposite the insertion opening, a longitudinal axis, and an inner diameter accommodating therein the fishing rod handle through the insertion opening and into the first pipe section along an insertion direction; a second pipe section – at 12 of Rudd and – at 12,14 of Roberts, connected at the connection area of the first pipe section and projecting away from the first pipe section along the longitudinal axis of the first pipe section; and the first pipe section having a slot – at 15, 17 of Rudd and – proximate 31 and 32 of Roberts, beginning at the insertion opening and extending in the insertion direction along the first pipe section – see for example figures 1-2 of Rudd and figures 1-3 of Roberts.

Referring to claim 2, Rudd and Roberts disclose the first and second pipe sections are two separate pieces removably connected to one another – see for example figures 1-2 of Rudd and figures 1-3 of Roberts.

Referring to claim 3, Rudd and Roberts disclose the second pipe section – at 12 of Rudd and – at 12, 14 of Roberts, has an outer pipe section – at the outer surface of – 12 of Rudd and - at 12 of Roberts, and an inner pipe section – at the inner surface of – 12 of Rudd and - proximate 18 of Roberts, connected to one another – see for example figures 1-2 of Rudd and figure 1 of Roberts.

Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudd.

Referring to claim 8, Rudd discloses the slot – at 15, 17, has a width adapted to a width of a bracket attaching the reel to the fishing rod so as to enable an insertion of the bracket beyond the insertion opening and to a given insertion depth into the first pipe section for removably securing the fishing rod within the fishing rod holder – see for example figures 1-7.

Referring to claim 9, Rudd discloses the slot is an L-shaped slot – at 15, 17, having a longitudinal component extending longitudinally from the insertion opening and a transverse component extending transversely away from the longitudinal component in a circumferential direction – see for example figure 3.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudd or Roberts as applied to claims 1 and 3 above.

Referring to claim 4, Rudd and Roberts do not disclose the outer pipe and inner pipe sections are connected to one another with an adhesive. However, this would have been an obvious matter of design choice to one of ordinary skill in the art, since applicant does not state that using an adhesive solves any particular problem or is done for any particular purpose over other types of fasteners.

Referring to claim 6, Rudd and Roberts do not disclose the first pipe and second pipe sections are connected to one another with glue. However, this would have been an obvious matter of design choice to one of ordinary skill in the art, since applicant does not state that using

glue solves any particular problem or is done for any particular purpose over other types of fasteners or adhesives.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudd or Roberts as applied to claim 1 above, and further in view of U.S. Patent No. 5,437,122 to Wilson. Rudd and Roberts do not disclose the first and second pipe sections are integrally formed. Wilson does disclose the first pipe section – at slot 16 and the second pipe section – at slot 20 are integrally formed – see for example figures 1-2. Therefore, it would have been obvious to one of ordinary skill in the art to take the device of Rudd or Roberts and add the first and second pipe sections integrally formed of Wilson, so as to make the device easier to manufacture and assemble while maintaining strength and durability. Further, making components integral renders the invention obvious as seen in *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudd or Roberts as applied to claim 1 above, and further in view of U.S. Patent No. 5,210,971 to Efantis. Rudd and Roberts further disclose the slot – at 15, 17 of Rudd and – proximate 24 of Roberts is substantially rectangular. Rudd and Roberts do not disclose the slot widens adjacent the insertion opening. Efantis does disclose a slot – see figure 2, which widens adjacent the insertion opening – see for example figure 2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Rudd or Roberts and add the slot of Efantis, so as to allow for the rod holder to easily receive the fishing rod unimpeded.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts as applied to claim 1 above, and further in view of Wilson. Roberts does not disclose the slot has a width adapted to a bracket of a fishing reel. Wilson does disclose the slot – at 16-20, has a width

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adapted to a width of a bracket attaching the fly fishing reel to the fly fishing rod, so as to enable an insertion of the bracket beyond the insertion opening and to a given insertion depth into the first pipe section for removably securing the fly fishing rod within the fly fishing rod holder – see for example figure 1. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Roberts and add the slot of Wilson, so as to allow for the fishing rod to be securely held in place during use.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts as applied to claim 1 above, and further in view of Rudd. Roberts does not disclose a L-shaped slot. Rudd does disclose the slot is an L-shaped slot – at 15, 17, having a longitudinal component extending longitudinally from the insertion opening and a transverse component extending transversely away from the longitudinal component in a circumferential direction – see for example figure 3. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Roberts and add the L-shaped slot of Rudd, so as to more securely hold the rod and reel in place during use.

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudd or Roberts as applied to claim 1 above, and further in view of U.S. Patent No. 4,485,579 to Hawie.

Referring to claim 10, Rudd and Roberts do not disclose the second pipe section is inserted into a flush mount fishing rod holder. Hawie does disclose the second pipe – at 11, has an outer diameter enabling an insertion thereof into a flush mount fishing rod holder – at 17 – see for example figure 1. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Rudd or Roberts and add the second pipe section mounted in a flush mount rod holder of Hawie, so as to allow for the rod to be secured proximate the water.

Referring to claim 11, Rudd as modified by Hawie and Roberts as modified by Hawie further disclose the second pipe section – at 11 of Hawie, has a plurality of notches – at 15, formed therein for engaging into an alignment pin – at 16 in the flush mount rod holder – 17 – see for example figures 1-4 of Hawie.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to fishing rod holders in general:

U.S. Pat. No. 2,576,624 to Miller – shows slot in pipe

U.S. Pat. No. 3,964,706 to Adams – shows slot in pipe

U.S. Pat. No. 4,372,072 to Comeau – shows slot in pipe

U.S. Pat. No. 4,375,731 to Budd – shows pipe with notches receiving rod

U.S. Pat. No. 4,407,089 to Miller – shows L-shaped slot

U.S. Pat. No. 4,578,891 to Murray – shows flush mounted rod holder

U.S. Pat. No. 5,065,540 to Potter, Jr. – shows flush mounted rod holder

U.S. Pat. No. 5,184,797 to Hurner – shows L-shaped slot

U.S. Pat. No. 5,446,989 to Stange et al. – shows slot in pipe

U.S. Pat. No. 5,697,183 to Walker – shows slot in pipe

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5. Any inquiry concerning this communication from the examiner should be directed to David Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on Monday-Friday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574.

A handwritten signature in black ink, appearing to read 'Peter M. Poon'.

Peter M. Poon
Supervisory Patent Examiner
Technology Center 3600